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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/067,976 | 02/08/2002 | George M. Hay | 86339-0002 | 3795 |
| 6449 | 7590 | 03/24/2005 | EXAMINER | |
| ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005 | | | RONES, CHARLES | |
| | | ART UNIT | PAPER NUMBER | |
| | | 2164 | | |
| DATE MAILED: 03/24/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/067,976 | HAY ET AL. | |
| | Examiner | Art Unit | |
| | Charles Rones | 2164 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 February 2002.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-21 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 2-8-02 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>8-6-04, 10-31-03, 11-05-02, 10-28-02</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because some drawing lines are faded and should be more defined.

Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 19, the phrase "may be" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Objections

Claims 20 and 21 are objected to because of the following informalities: Lines 11-13 contain "--" which should be deleted.. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 12-16, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yuen et al. U.S. Patent Publication No. 2002/0054073 ('Yuen') in view of Chrabaszcz et al. U.S. Patent No. 6,154,835 ('Chrabszcz'), in further view of Fox et al. U.S. Patent Publication No. 2002/0116421 ('Fox').

Yuen discloses:

As to claim 1,

- a) a pre-recorded audio narration file of substantially an entire book stored on a single computer readable medium;
- b) an electronic text file of substantially the entire book stored on said computer readable medium; See Abstract; paragraphs: [0013]; [0015];
- c) a synchronization file linking time signatures of the pre-recorded audio narration with locations in the electronic text stored on said computer readable medium; See Abstract; paragraphs: [0013]; [0015];
- d) a reader program adapted to cause a computer to display text of the book, to play the pre-recorded audio narration of the book, and to allow a user to link there-between as desired using the linking file stored on said computer readable medium; See Fig. 1; Abstract; paragraphs: [0006]; [0018].

Yuen discloses the claimed invention except for an automatic installation program to automatically install the reader software upon placement of the computer readable medium within a computer stored on said computer readable medium. Chrabaszcz teaches that it is known to provide an automatic installation program to automatically install the reader software upon placement of the computer readable medium within a computer stored on said computer readable medium. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide an automatic installation program to automatically install the reader software

upon placement of the computer readable medium within a computer stored on said computer readable medium as taught by Chrabaszcz, since Chrabaszcz states at column 10, lines 3-25 that such a modification would allow a user to install a program quickly and without having to perform cumbersome and time consuming tasks as required in prior art methods of installing this application program.

The modified invention of Yuen discloses the claimed invention except for the a container housing said computer readable medium, said container having a picture that is visible from a front surface thereof that is substantially the same as that on a hard-cover copy of the book, and having a spine from which is visible a title of the book and/or the author's name. Fox teaches that it is known to provide a container housing said computer readable medium, said container having a picture that is visible from a front surface thereof that is substantially the same as that on a hard-cover copy of the book, and having a spine from which is visible a title of the book and/or the author's name. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a container housing said computer readable medium, said container having a picture that is visible from a front surface thereof that is substantially the same as that on a hard-cover copy of the book, and having a spine from which is visible a title of the book and/or the author's name as taught by Fox, since Fox states at [0213] that such a modification would allowed the complete document to be constructed in virtual space.

As to claim 2,

wherein said computer readable medium is a single CD; See Chrabasczcz: 9:6-23; 10:1-25.

As to claim 12,

wherein said computer readable medium includes only read-only memory, CD-Rom (Compact Disc- Read Only Memory); See Fox: [0019].

As to claim 13,

wherein at least said audio and text portions of said computer readable medium are contained within read-only memory; See Fox: [0164]; [0214].

As to claim 14,

wherein said computer readable medium includes portions that are write-able;
See Fox: [0214].

As to claim 15,

wherein the reader software is adapted to create a personal file and to save the same in said write-able portion of said computer readable medium, wherein said personal file includes bookmarks and/or annotations wherein a file is deemed to include a personal file and the data is non-functional material; See Fox: [0126]; [0221].

As to claim 16,

wherein said audio and text portions are adapted such as to prevent copying thereof; See Fox: [0221].

As to claim 19, as best taught and understood,

The modified invention of Yuen discloses the claimed invention except for wherein said reader software is adapted to create a library, wherein said library includes electronic books stored on a particular computer and electronic books that are not stored on the computer but that may be accessible to a user. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide wherein said reader software is adapted to create a library, wherein said library includes electronic books stored on a particular computer and electronic books that are not stored on the computer but that may be accessible to a user since it was known in the art that libraries have lists of books some of which are already checked out and computerizing a catalog of the books available and those checked out would keep track of the books instock and those not available or not located on the shelf so that it could be locate if in fact the library carried the book.

As to claims 20 and 21,

- a) obtaining a raw audio recording file of a human narration of a book; See [0009]; Fox: [0217];
- b) audio editing the audio file; See [0014-0015]; Fox: [0214];
- c) segmenting the audio file; See [0014-0015]; Fox: [0214];
- d) converting the segmented files into a compressed format; See [0014-0015]; Fox: [0163-0164];
- e) obtaining an electronic format text version of said book; See [0014-0015];
- f) separating the text version of the book into multiple documents; See [0014-0015]; Fox: [0214];
- g) using a creator program at an editor's station:
 - playing the audio obtained in step e); See [0014-0015]; Fox: [0214];
 - concurrently viewing text obtained in step g); See [0014-0015]; Fox: [0214];
 - creating a synchronization file linking the audio and text files; See [0014-0015]; Fox: [0214];
- h) publishing the audio files from step d) for said pre-recorded audio narration file, the electronic text documents of step f) for said electronic text file, the synchronization file of step g) for said synchronization file, said reader program and said automatic installation program to said computer readable medium so as to create a computer-readable-medium-electronic book; See [0014-0015]; Fox: [0214].

Claims 3-5 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yuen et al. U.S. Patent Publication No. 2002/0054073 ('Yuen') in view of Chrabasczcz et al. U.S. Patent No. 6,154,835 ('Chrabasczcz'), in view of Fox et al. U.S. Patent Publication No. 2002/0116421 ('Fox').

As to claim 3,

The modified invention of Yuen discloses the claimed invention except for wherein said audio is contained within an MP3 compression format. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide wherein said audio is contained within an MP3 compression format since it was known in the art that MP3 was a common and standard audio digital format that most portable devices would support to play/record audio.

As to claim 4,

wherein said text is in an RTF format; See Fox: [0214].

As to claim 5,

wherein said linking file is an XML file; See Fox: [0115].

As to claim 17,

The modified invention of Yuen discloses the claimed invention except for wherein said container is dimensioned such that a height and front-width are substantially the same as that of a standard paper-back book. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide wherein said container is dimensioned such that a height and front-width are substantially the same as that of a standard paper-back book since it was known in the art that using a standard book size was common and would appear as a user had come to expect and that a user can be familiar in seeing a book in a standard size.

Claims 6-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yuen et al. U.S. Patent Publication No. 2002/0054073 ('Yuen') in view of Chrabaszcz et al. U.S. Patent No. 6,154,835 ('Chrabaszcz'), in view of Fox et al. U.S. Patent Publication No. 2002/0116421 ('Fox').

The modified invention of Yuen does not expressly show wherein said reader program is adapted to create a personal XML file that contains personal information related to a user; wherein said personal XML file includes information related to bookmarks; wherein said personal XML file includes information related to annotations; wherein said personal XML file includes information related to highlighting; wherein said reader software is adapted to save the personal XML file to a digital data storage

device; wherein said reader software is adapted to save the personal XML file upon the computer readable medium.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The adapting and creating steps would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to adapt and create software wherein said reader program is adapted to create a personal XML file that contains personal information related to a user; wherein said personal XML file includes information related to bookmarks; wherein said personal XML file includes information related to annotations; wherein said personal XML file includes information related to highlighting; wherein said reader software is adapted to save the personal XML file to a digital data storage device; wherein said reader software is adapted to save the personal XML file upon the computer readable medium., because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

A limitation on a claim can broadly be thought of then as its ability to make a meaningful contribution to the definition of the invention in a claim. In other words, language that is not functionally interrelated with the useful acts, structure, or properties of the claimed invention will not serve as a limitation. See *In re Gulack*, 217 USPQ 401 (CAFC 1983), *Ex parte Carver*, 227 USPQ 465 (BdPatApp&Int 1985) and *In re Lowry*, 32 USPQ2d 1031 (CAFC 1994) where language provided certain limitations because of specific relationships required by the claims.

MPEP 2106 IV B 1 (b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way in which computing processes are performed".

Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability)."
(emphasis added)

The claim limitation language of "personal XML file that contains personal information related to a user; wherein said personal XML file includes information related to bookmarks; wherein said personal XML file includes information related to annotations; wherein said personal XML file includes information related to highlighting" (material).

Provided the data is found to be nonfunctional, a rejection can be made even if the prior art does not teach the exact content of data. This is because nonfunctional data is not processed by the computer or it does not alter the process steps, it only means something to the human mind. Common limitations where nonfunctional data *could be* found include those directed to sending, receiving storing and displaying data. Stated another way, according to the decision in *Lowry* mentioned above, prior court cases involving nonfunctional descriptive material "have no factual relevance if invention requires that information be processed by computer rather than the human mind."

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yuen et al. U.S. Patent Publication No. 2002/0054073 ('Yuen') in view of Chrabasczcz et al. U.S. Patent No. 6,154,835 ('Chrabasczcz'), in view of Fox et al. U.S. Patent Publication No. 2002/0116421 ('Fox'), in further view of Marsh U.S. Patent No. 6,142,721 ('Marsh').

The modified invention of Yuen discloses the claimed invention except for wherein said container is dimensioned such that it has a height of between about 6 and 9 includes and a front-width of between about 4 and 6 inches. Marsh teaches that it is known to provide wherein said container is dimensioned such that it has a height of between about 6 and 9 includes and a front-width of between about 4 and 6 inches. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide wherein said container is dimensioned such that it has a height of between about 6 and 9 includes and a front-width of between about 4 and 6 inches as taught by Marsh, since Marsh states at column 7, lines 65-67; column 8, lines 1-17 that such a modification would the container to be dimensioned the same as a standard book size.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Rones whose telephone number is 571-272-4085. The examiner can normally be reached on Monday-Thursday 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on 571-272-4083. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Charles Rones
Primary Examiner
Art Unit 2164

March 16, 2005